



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,939	03/08/2005	Ulrich Mueller	267013US0PCT	7566
22850	7590	09/08/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
WOOD, ELIZABETH D				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
09/08/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/526,939

Applicant(s)

MUELLER ET AL.

Examiner

Elizabeth D. Wood

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35 and 37-48 is/are pending in the application.
- 4a) Of the above claim(s) 47 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35 and 37-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Specification

The examiner has not checked the specification to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical and idiomatic). Cooperation of the applicant(s) is requested in correcting any errors of which applicant(s) may become aware of in the specification, in the claims and in any future amendment(s) that applicant(s) may file.

Applicant(s) is also requested to complete the status of any copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

The status of the parent application(s) and/or any other application(s) cross-referenced to this application, **if any**, should be updated in a timely manner.

Election/Restriction

Applicant's arguments with respect to the withdrawal of claims 47 and 48 in the reply filed on July 21, 2008 are acknowledged. The traversal is on the ground(s) that the examiner did not determine the claims to be independent and distinct. This is not found persuasive because it is not correct. The previous office action indicated

"The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant

case the composition as claimed has utility for materially different processes such as the oxidation of an aldehyde or ketone to carboxylic acid.”

With respect to burden, it should be clear that the examination of an independent and distinct invention would constitute prima facie evidence of burden. These claims would not even be classified nor examined in the same Technology Center with the catalyst claims. As a result, the determination of patentability would be expected to involve substantially different questions of patentability.

With respect to the foregoing, the argument's regarding the restriction are not technically correct because this is a 371 application. Accordingly, the only criteria with respect to examination is whether the shared technical feature of the claims (the catalyst composition) is novel or unobvious. And because the catalyst claims are under rejection in this application under 35 USC 103(a), the requirement for restriction is proper.

Finally, the applicant's statements indicating that the subject matter of these claims finds clear support in original claim 34 is not convincing. Claim 34 was not an "original" claim, in that it was added by preliminary amendment. Additionally, it was rejected in the first office action as being directed to non-statutory subject matter because it was not drafted as a proper process claim. The rejection specifically indicated that the claim would not be further treated on the merits. Therefore, applicant's conclusion that claims 47 and 48 have already been treated on the merits is clearly erroneous based on an examination of the file record.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The rejection of the claims under the second paragraph of 35 USC 112 is withdrawn in view of the amendments to the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 35-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,054,112 to Hasenzahl et al. in view of US 5,919,430 to Hasenzahl et al.

The newly presented claims require a process for producing a zeolite comprising the steps of crystallization, separation, calcinations, contact with deionized water, shaping and calcining, and the catalyst produced thereby.

Hasenzahl et al. '112 disclose a process for the production of TS-1 materials that involves the steps of crystallization, washing with deionized water, calcination, treatment with ammonium acetate, further washing with deionized water, and further calcination. This does not differ substantively from the presented claims. See particularly column 4 and the examples. The disclosure indicates that the materials can be converted to a form suitable for application comprising the same steps employed by applicant, but does not indicate where in the process such shaping steps should be conducted. Limitations such as the claimed UV/VIS characteristics are considered to flow from the process of making a product as taught by Hasenzahl et al. '112.

Hasenzahl et al. '430 produce a closely analogous catalyst composition, and provides specific information that the material may be shaped before, during or after calcinations, and before or after the washing steps. Accordingly, it would have been obvious to select any known method for shaping and the time in the production process based on the knowledge set forth in the prior art regarding the conventionality of these steps. See particularly column 5.

Response to Arguments

Applicant's arguments with respect to claims 35 and 37-46, filed July 21, 2008, have been considered but have not been found convincing.

The arguments presented assert that there is criticality associated with the order of process steps, in contrast to the Hasenzahl documents which indicate that there is no criticality in the order of the steps to produce a functional catalyst composition. Applicant's argues that the information in the specification establishes the criticality of the order of steps and results in a superior catalyst.

This line of reasoning is not convincing to the examiner. The specification compares a composition which has been washed under certain conditions to a composition that has not been washed. The examiner would submit that this improvement would have been obvious and expected; it is well known in myriad arts that washing improves the purity of materials and the more they are washed, the better they perform.

In any event, and assuming arguendo the examiner considered washing to be a novel improvement the claimed steps additionally do not contain many of the limitations found in the examples. The exemplified materials are calcined materials that are washed, calcined, shaped, dried and calcined again, and all of these steps in this order are not claimed in the instant application. Moreover, specific conditions take place during the washing step in the examples that are not set forth in the instant claims. As a result, there is no evidence on this file record commensurate in scope with the claims

that would support patentability of the instantly claimed composition and method for the production thereof.

Conclusion

Applicants are advised that any evidence to be provided under 37 CFR 1.131 or 1.132 and any amendments to the claims and specification should be submitted prior to final rejection to be considered timely. It is anticipated that the next office action will be a final rejection.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 571-272-1377. The examiner can normally be reached on M-F, 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth D. Wood/
Primary Examiner, Art Unit 1793

/E. D. W./
Primary Examiner, Art Unit 1793